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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,829	07/12/2000	Francis J. Kronzer	11301-0901	3150

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EXAMINER

TORRES VELAZQUEZ, NORCA LIZ

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/06/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/614,829

Applicant(s)

KRONZER, FRANCIS J.

Examiner

Norca L. Torres-Velazquez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election with traverse of Group I in Paper No. 11 is acknowledged. The traversal is on the ground(s) that finding of allowability of the heat transfer material would necessitate the allowance of the method claims as well for using a patentable article. This is not found persuasive because the heat transfer material can be made by applying heat only. The product as claimed does not require the use of heat and pressure to be produced.

The requirement is still deemed proper and is therefore made FINAL.

Regarding the species election, it has been withdrawn. Therefore, Claims 1-14 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9 and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: there is no spatial relationship of the "one or more layers". It is not clear whether the heat transfer material as claimed in claim 1 will form one of the claimed layers on claim 9. Further, there is no spatial relationship for the base substrate, a sub-coating layer, a top coating layer, or a combination thereof.

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5. Claim 12 recites the limitation "image-bearing coating" in line 2. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 13 recites the limitation " image-bearing coating" in line 2. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 14 recites the limitation "image-bearing coating" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-5, 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by KOMETANI (US 5,670,448).

KOMETANI discloses a recording sheet for making transparencies that includes a transparent substrate 2 having a recorded major surface and a support sheet 4 releasable provided on the opposed major surface of the substrate 2, between which a thermoplastic resin layer 3 interleaved by an extrusion coating technique. (Column 2, lines 45-55; Figure 1)

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The reference further discloses the use of a receiving layer 5 provided on the recorded surface of the transparent substrate 2, an anchor coat layer 6 may be disposed between the support sheet 4 and the thermoplastic resin layer 3 provided by the extrusion coating technique, and a slip layer 7 may be formed on the back surface side of the support sheet 4. (Column 2, lines 56-63)

KOMETANI further discloses that the substrate is preferably a film formed of thermoplastic resins and that the receiving layer is formed of a binder resin and it may be of either mono- or multi-layer structure. (Column 3, lines 3-41) KOMETANI further teaches the use of an interlayer interleaved between the transparent substrate and the receiving layer and the use of a thermoplastic resin layer between the substrate film and the support sheet. (Column 4, lines 42-58) The reference further teaches that the support sheet may be formed of cellulose fiber paper, synthetic paper, foamed film, white film, synthetic resin film having fine asperities on the surface, and the like. (Column 5, lines 23-26) The slip layer may be provided on the back surface of the support sheet so as to improve the ability of the sheet to be mechanically fed, and prevent defects such as curling. (Column 7, lines 45-48).

10. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by KRONZER (US 5,798,179).

KRONZER discloses a printable heat transfer material having cold release properties, which material includes a flexible first layer that will typically be a film or a cellulosic nonwoven web. A second layer overlays the first surface of the first layer and includes a thermoplastic polymer. A third layer overlays the second layer and includes a thermoplastic polymer, which melts in a range of from about 65°C to about 180°C. The reference further

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discloses a third layer that may include a film-forming binder, which binder may include a powdered thermoplastic polymer. For an ink jet printable heat transfer material, a fourth layer may overlay the third layer, which fourth layer includes a film-forming binder and a powdered thermoplastic polymer. KRONZER further discloses that a fifth layer may overlay the second layer, thereby being located between the second layer and the third layer. The fifth layer may include a film-forming binder, which melts in a range of from about 65°C to about 180°C.

(Abstract)

The KRONZER reference teaches the use paper in the first layer. (Refer to Column 5, lines 17-20) Also that the third layer may be a melt-extruded film. (Column 6, line 43) The reference also teaches a fifth or intermediate layer located between the second layer and the third layer. This layer prevents delamination of the second and third layers (Column 8, lines 32-46)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KOMETANI.

Claims 6-8 are rejected over KOMETANI as stated above on paragraph 9, and further the KOMETANI reference teaches the use of thermoplastic resins such as ethylene vinyl acetate copolymer resin, polyester resins and polyolefin resins in the production of the meltable layers of their invention. (Refer to Column 3, lines 29-31; Column 4, lines 65-67; Column 5, lines 1-40)

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It is noted that KOMETANI is silent with respect to the claimed melt flow index and softening temperatures. However, it is reasonable to presume that the claimed melt flow index and softening temperatures for the meltable layers are inherent to the invention of KOMETANI. Support for said presumption is found in the use of the same starting materials (i.e. ethylene vinyl acetate copolymer resin, polyester and polyolefin resins), like processes of making the articles, and the production of similar end products. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the presently claimed function of the claimed melt flow index and softening temperatures would obviously have been provided as a result of the inventive thermoplastic resin layers of the KOMETANI reference. *Note In re Best*, 195 USPQ 433.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

AGLER et al. (US 6,358,660 B1)

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 703-306-5714. The examiner can normally be reached on Monday-Thursday 8:30-2:30 pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

nlt

November 1, 2002

Elizabeth M. Cole
ELIZABETH M. COLE
PRIMARY EXAMINER